

REMARKS

This Amendment is responsive to the second Office Action dated May 21, 2002. Claims 1-20 are pending in the present application. Claims 1 and 13 were amended. Consequently claims 1-20 remain pending.

The Examiner has reopened prosecution for the present case with a Final Office Action in response to the filing of the Appeal Brief. It should be noted that according to MPEP §2108.02, prosecution may only be reopened to enter a new ground of rejection. As the Final Office Action states no new grounds of rejection, or even acknowledges any reason why prosecution was reopened, it is believed the finality of the Office Action is improper, and Applicant request that it be withdrawn.

Claims 1 and 13 were amended to include recitations more compatible with claim 8. Claim 1 was amended to recite “automatically generating *in the image capture device* an Internet page description file,” rather than “automatically generating an Internet page description file in the image capture device. Similarly, claim 13 was amended to recite “automatically generating *in the image digital camera* an HTML file.” Claim 13 was also amended to recite “without the need for *the user to load* communication software onto the host computer,” rather than “without the need for loading camera-specific communication software.”

Prior Art Rejections

In Final Office Action, the Examiner maintained rejection of claims 1, 8, 11-13 under 35 U.S.C. §103(a) as being unpatentable over Xu (U.S. Patent No. 5,848,420) (“Xu”) in view of Narayen et al. (U.S. Patent No. 6,035,323) (“Narayen”). Claims 2-5, 9-10, 14-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Xu and Narayen, as applied to claim 1, and

further in view of Cohen et al. (U.S. Patent No. 5,805,829). The Examiner rejected claims 6-7 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Xu and Narayan, as applied to claim 5, and further in view of Wang et al. (U.S. Patent No. 6,058,428).

1. Xu in View of Narayan Fails to Teach or Suggest Automatically Generating an Internet Page Description File or HTML File In An Image Capture Device or a Digital Camera That References the Images Stored Therein.

In responding to Applicant's Arguments and maintaining the rejection of independent 1, 8 and 13, the Examiner considered the step of "generating an Internet page description file" in claims 1 and 13 to be different, and therefore inconsistent, with claim 8, which recites that the means for generating happens within the camera. In response, claims 1 and 13 have been amended to make clear that that the Internet page description file is automatically generated "in the image capture device."

As argued previously, Xu in view of Narayan fails to teach or suggest automatically "generating an Internet page description file" or HTML file *in the image capture device or digital camera* that references the images stored therein, as recited in claims 1, 8 and 13. In contrast, Narayan requires that the digital images be *downloaded* from the digital camera into "a digital processing system, such as a computer system". (Col. 6, lines 31-34). Once the images are stored in the computer system, the user creates an album. The album format data and the images are then transmitted to a server. (Col. 8, lines 21-42). When a request to view the album is received by the server, the server generates the appropriate HTML format and sends the page to the web browser which requested a viewing of the album." (Col. 8, lines 45-58). Thus, in Narayan, it is the server that generates the web viewable file, rather than the camera.

Accordingly, Xu in view of Narayan fail to teach or suggest automatically generating "in

the image capture device” or “in the digital camera” an Internet viewable file, such as an HTML, as recited in claims 1, 8 and 13.

2. Xu in View of Narayen Fails to Teach Or Suggest Generating In The Image Capture Device An Internet Page Description File That References Image Stored In The Image Capture Device.

Claims 1, 8, and 13 recite that the Internet page description file (or the HTML file) “references the images *stored*” in the imaging device or digital camera. In the present invention, the images need not be uploaded to the host computer system. Rather, once the camera is mounted as disk, a user uses a web browser to open the HTML file in the camera and view the images still stored in the device. In contrast, a combination of Xu and Narayen requires that the images be uploaded to the computer, and further from the computer to the server. The HTML generated by the server references the image stored on the server.

Accordingly, Xu in view of Narayen fail to teach or suggest automatically generating “in the image capture device” or “in the digital camera” an HTML file that references the images stored in the device, as recited in claims 1, 8 and 13.

3. Xu in View of Narayen Fails to Teach or Suggest Using A USB Connection Between The Digital Camera And The Host Computer, And Identifying The Digital Camera To The Host Computer As A Mass Storage Device Class, Whereby The User Need Not Load Communication Software Onto The Host Computer.

The Examiner maintains that Xu teaches establishing communication between the image capture device and the computer, and mounting the image capture device as a disk without having to load device-specific software, since the connection is made with a serial port and the Xu’s software program is not device- or camera-specific. Even if this is true, XU fails to teach or

suggest the steps of “establishing a Universal Serial Bus (USB) connection between the digital camera and the host computer;” and identifying the digital camera to the host computer as a mass storage device class whereby the digital camera appears to the host computer as a disk,” as recited in Claim 13.

As further recited in amended claim 13, “the images stored in the digital camera are displayed on the host computer through the web browser *without the need for the user to load communication software* onto the host computer. The Specification states that, “[t]o identify itself as a mass storage device class to the PC’s 112 operating system 116, the digital camera 110 includes USB Mass Storage Device Class server-software that operates in accordance with USB protocols to identify to the OS 118 that the device is a mass storage device.” Specification, page 10, lines 7-10. Because *the digital camera contains the Device Class server-software*, the host computer does not need any other software to mount the digital camera as a disk volume. In contrast, XU specifically *requires* the user to load a software program on the host.

Accordingly, Xu in view of Narayen fail to teach or suggest using a USB connection between the digital camera and the host computer, and identifying the digital camera to the host computer as a mass storage device class, whereby the user need not load communication software onto the host computer, as recited in claim 13.

4. There Is No Suggestion For Combining The Teaching Of The References To Produce The Present Invention As Claimed.

It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion, or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). It is respectfully submitted that the cited references do not suggest

(expressly or by implication) combining the teaching of the references to produce the present invention as claimed.

Xu discloses a method and system for accessing data of digital camera from a personal computer and is directed to a method for improving the mode of operating a computer system that retrieves data from a digital camera where access through the serial port is the only means of retrieving the images. Xu solves this problem with a software program that is loaded onto the host computer to permit the computer to access the memory in the digital camera through the serial port to make the memory of the camera appear as a disk to the operating system.

In contrast, Narayen is directed to the distribution of a collection of digital media (images) with automatic generation of presentable media that allows a user to easily distribute or publish images from the digital camera over a network, such as the Internet. It is respectfully submitted that there is simply no teaching or suggestion in these disparate references to combine one with the other to produce the claimed invention. In absence of any teaching or suggestion to the contrary, it is believed the §103 rejection based on Xu and Narayen is improper.

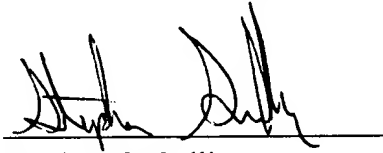
For the reasons discussed above, Applicants respectfully submit that claims 1, 8 and 13 are allowable over Xu and Narayen. Claims 2-7, 9-12, and 14-20 depend on independent claims 1, 8, and 13 respectively. Accordingly, the arguments above apply with equal force to the dependent claims. Applicant respectfully submits, therefore, that claims 2-7, 9-12, and 14-20 are allowable over the cited references.

In view of the foregoing, it is submitted that the claims in the application are patentable over the cited reference and are in condition for allowance. Reconsideration of the rejections and objections is requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made".

Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Stephen G. Sullivan', is written over a horizontal line.

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July 22, 2002

Date



MASKED VERSION TO SHOW CHANGES MADE

1. ~~(Amended)~~ A method for viewing images from an image capture device on a host computer, comprising steps of:

- a) establishing communication between the image capture device and the host computer;
- b) automatically generating ~~in the image capture device~~ an Internet page description file ~~in the image capture device~~ that references the images stored therein;
- c) mounting the image capture device as a disk on the host computer; and
- d) opening the Internet page description file in a web browser on the host computer, wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.

13. ~~(Amended)~~ A computer-readable medium containing program instructions for viewing images from a digital camera on a host computer, the program instructions for:

- a) automatically generating ~~in the image digital camera~~ an HTML file that references the images stored in the digital camera;
- b) establishing a Universal Serial Bus (USB) connection between the digital camera and the host computer; and
- c) identifying the digital camera to the host computer as a mass storage device class whereby the digital camera appears to the host computer as a disk, thereby allowing a user to open the HTML file in a web browser on the host computer, wherein the images stored in the digital camera are displayed on the host computer through the web browser without the need for

... communication software onto the host computer.